

Practitioner's Docket No.: 59930(47992)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Nancy Smyth-Thompson, et al.

Application No.: 09/991,028

Group No.: 1615

Filed: November 20, 2001

Examiner: G. Kishore

For: NOVEL LIPOSOME COMPLEXES FOR INCREASED SYSTEMIC DELIVERY

☐ *Patent No.: N/A

Issue Date: N/A

Reexamination Date: N/A

*NOTE: Preferably also insert inventor's name and invention title.

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

TERMINAL DISCLAIMER TO OBVIATE
A DOUBLE PATENTING REJECTION (37 C.F.R. SECTION 1.321(c))

Identification of Person(s) Making This Disclaimer

I, Gregory B. Butler, Ph.D., Esq.

(type or print names of all inventors or assigns or name of attorney signing disclaimer)

(a) represent that I am

☐ an inventor (applicant) of this invention.

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. SECTION 1.8(a))

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

☒ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

FACSIMILE

☐ transmitted by facsimile to the Patent and Trademark Office, (703) 746-5112

Date:

JAN. 7, 2004

Signature



Deanna P. Davis

Gregory B. Butler
(type or print name of person certifying)

(Terminal Disclaimer to Obviate a Double Patenting Rejection--page 1 of 7)

☐ an assignee of this invention.

WARNING: *"If the patent or patent application is assigned to an organization, such as a corporation, partnership, university, [g]overnment agency or similar entity, and the disclaimer is signed by the assignee, the assignee must comply with Section 3.73(b)." Notice of Oct. 15, 1993, 1156 O.G. 54-61 at 56, Section 1490, M.P.E.P., 7th Edition.*

☐ a representative authorized to sign on behalf of the assignee identified below.

☐ A statement under 37 C.F.R. Section 3.73(b) is attached.

WARNING: *See the above "WARNING".*

☒ the attorney of record for this invention.

NOTE: *The rules "permit an attorney or agent of record to sign a terminal disclaimer without the need to comply with Section 3.73(h)." Notice of Oct. 15, 1993, 1156 O.G. 54-61, at 56. See also Section 1490, M.P.E.P., 7th Edition.*

IDENTITY OF ASSIGNEE AND TITLE OF DISCLAIMANT
(if applicable)

The assignee is

Name of assignee _____

Address of assignee _____

Title of disclaimant authorized to sign on behalf of assignee _____

EXTENT OF DISCLAIMANT'S INTEREST

The extent of the interest in this invention that the disclaimant owns is in:

☐ the whole of this invention.

☒ a sectional interest in this invention, as follows: Claims 8-12 and 15-19.

(state the exact interest of the disclaimant)

(Terminal Disclaimer to Obviate a Double Patenting Rejection—page 2 of 7)

RECORDAL OF ASSIGNMENT IN PTO
(if applicable)

☒ The assignment was recorded on October 15, 1999, in the parent case U.S.S.N. 09/242,190

Reel 010283

Frame 0917

☐ Authorization for recordal of the assignment is separately attached.

☐ A separate ☐ "ASSIGNMENT (DOCUMENT) COVER SHEET" or
☐ FORM PTO 1595 is also attached.

ESTABLISHING RIGHT OF ASSIGNEE TO TAKE ACTION
(if applicable)

☐ Attached is a STATEMENT UNDER 37 C.F.R. Section 3.73(b) establishing the right of the assignee to take action in this case.

DISCLAIMER
(select one of the following)

(Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application)

Petitioner hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of any patent granted on Application No. _____, filed on _____, as shortened by any terminal disclaimer. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the above-listed application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

In making the above disclaimer, disclaimant does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. Sections 154 to 156 and 173 of any patent granted on the application forming the basis of the double patenting rejection, namely, any patent granted on Application No. _____, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. Section 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

(Terminal Disclaimer to Obviate a Double Patenting Rejection--page 3 of 7)

DISCLAIMER FEE (37 C.F.R. Section 1.20(d))

- ☐ Other than a small entity--fee \$110.00
- ☐ Small entity--fee \$55.00
- ☐ Small entity statement attached
- ☐ Small entity statement already filed
- ☐ in patent application ____/____ on _____ (date)

OR

(Obviousness-Type Double Patenting Rejection Over A Prior Patent)

Petitioner hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of Patent No. US 6,413,544 B1 as presently shortened by any terminal disclaimer. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the above-listed patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

In making the above disclaimer, disclaimant does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. Sections 154 to 156 and 173 of the patent forming the basis of the double patenting rejection, namely, Patent No. US 6,413,544 B1, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. Section 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

DISCLAIMER FEE (37 C.F.R. Section 1.20(d))

- ☒ Other than a small entity--fee \$110.00
- ☐ Small entity--fee \$55.00
- ☐ Small entity statement attached
- ☐ Small entity statement already filed
- ☐ in patent application ____/____ on _____ (date)

OR

(Terminal Disclaimer to Obviate a Double Patenting Rejection--page 4 of 7)

**(Provisional Obviousness-Type Double Patenting Rejection Over A Pending
Application--Reexamination Proceeding)**

Petitioner hereby disclaims, except as provided below, the terminal part of any patent being reexamined, which would extend beyond the expiration date of any patent granted on Application No. _____/_____, filed on _____, as shortened by any terminal disclaimer. Petitioner hereby agrees that any reexamination certificate issued on the instant patent being reexamined shall be enforceable only for and during such period that it and any patent granted on the above-listed application are commonly owned. This agreement runs with any reexamination certificate issued on the instant patent granted and is binding upon the grantee, its successors, or assigns.

In making the above disclaimer, disclaimant does not disclaim the terminal part of any reissue certificate granted on the instant patent being reexamined that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. Sections 154 to 156 and 173 of any patent granted on the application forming the basis of the double patenting rejection, namely, any patent granted on Application No.: ____/_____, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. Section 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

DISCLAIMER FEE (37 C.F.R. Section 1.20(d))

- ☐ Other than a small entity--fee \$110.00
- ☐ Small entity--fee \$55.00
- ☐ Small entity statement attached
- ☐ Small entity statement already filed
- ☐ in patent application ____/_____ on _____ (date)

OR

**(Provisional Obviousness-Type Double Patenting Rejection Over A Prior Patent--
Reexamination Proceeding)**

Petitioner hereby disclaims, except as provided below, the terminal part of the patent being reexamined, which would extend beyond the expiration date of Patent No. _____ as presently shortened by any terminal disclaimer. Petitioner hereby agrees that the patent for which a reexamination certificate is issued as a result of this proceeding shall be enforceable only for and during such period that it and the above listed patent granted are commonly owned. This agreement runs with any reexamination certificate issued on the instant patent and is binding upon the grantee, its successors, or assigns.

(Terminal Disclaimer to Obviate a Double Patenting Rejection--page 5 of 7)

In making the above disclaimer, disclaimant does not disclaim the terminal part of any reexamination certificate granted on the instant patent that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. Sections 154 to 156 and 173 of the patent forming the basis of the double patenting rejection, namely, Patent No.: _____, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. Section 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

DISCLAIMER FEE (37 C.F.R. Section 1.20(d))

☐ Other than a small entity--fee \$110.00

☐ Small entity--fee \$55.00

☐ Small entity statement attached

☐ Small entity statement already filed

☐ in patent application ____/____ on

(date)

(Terminal Disclaimer to Obviate a Double Patenting Rejection--page 6 of 7)

FEE PAYMENT

[] Attached is a check in the sum of \$_____.

[] Charge Account _____ for any fee deficiency.

[X] Charge Deposit Account ~~04-1105~~ the sum of \$110.00.
A duplicate of this disclaimer is attached.

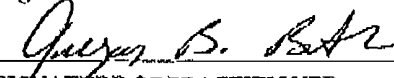
Date: 1-7-04

Reg. No.: 34,558

Customer No.: 21874

BOS2_350872.1

Signature of disclaimant


SIGNATURE OF PRACTITIONER

Gregory B. Butler, Ph.D., Esq.
(type or print name of practitioner)

EDWARDS & ANGELL, LLP
P.O. Box 9169
Boston, Massachusetts 02209

(Terminal Disclaimer to Obviate a Double Patenting Rejection--page 7 of 7)

Edwards & Angell_{LLP}

101 Federal Street Boston, MA 02110 617.439.4444 fax 617.439.4170
www.EdwardsAngell.com

Date: 1-7-04Pages (including cover): 17

Sender:

Name Gregory Butler

Fax

Phone (617) 517-5595

Email

To: EXAMINER Kishore Act Unit 1615
Name Company Fax Phone

FAX: (703) 746-5112If you experience problems receiving this fax, please call (617) 517-5595.

Message:

EXAMINER Kishore,

I will call you to confirm your
Receipt of this Response and Terminal Discharge.

Fax

Confidentiality Note: The documents accompanying this facsimile contain information from the law firm of Edwards & Angell LLP, which may be confidential and/or privileged. The information is intended only for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution or the taking of any action in reliance on the contents of this facsimile is strictly prohibited, and that the documents should be returned to this firm immediately. If you have received this facsimile in error, please notify us by telephone immediately so that we can arrange for the return of the original documents to us at no cost to you.